



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/512,101

10/21/2004

Michael Rooke

915-006.054

6418

4955 7590 05/07/2007
WARE FRESSOLA VAN DER SLUYS &
ADOLPHSON, LLP
BRADFORD GREEN, BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

EXAMINER

HOLLIDAY, JAIME MICHELE

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

05/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/512,101	Applicant(s) ROOKE ET AL.	
	Examiner Jaime M. Holliday	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 8, 2007 has been entered.

Response to Amendment

Response to Arguments

2. Applicant's arguments with respect to **claims 1-12 and 15-19** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-12 and 15-19** are rejected under 35 U.S.C. 103(a) as being obvious over **Salin et al. (U.S. Patent # 6,370,390 B1)** in view of **Rooke et al. (Pub # U.S. 2002/0044634 A1)**.

Consider **claims 1, 9-12 and 17**, Salin et al. clearly show and disclose a method for delivering short messages to mobile stations. Salin et al. further disclose a situation where a mobile station MS is attached to a GPRS network and a GSM network, and the short message service center (SM-SC) has received a short message (SM) for delivery to the mobile station, but the mobile station cannot be reached. The SM-SC first forwards the short message to the gateway mobile switching center for short message service (SMS-GMSC) which proceeds to request routing information for the short message from the home location register (HLR) of the mobile station, (abstract, column 7 lines 60-65 and column 8 lines 8-16) characterized by: sending a Set Message Waiting Data message to the HLR of the MS in response to a failed delivery attempt (Failure Report) to the SMS-GMSC, reading on the claimed "a method (software tool; computer program product; computer program product; apparatus) comprising receiving a notification from a store and forward entity about an unsuccessful delivery attempt of a message to a mobile terminal device," (figure 2, column 8

lines 39-42 and 59-62) and acknowledging receipt of Set Message Waiting Data message from SMS-GMSC to HLR, reading on the claimed "subscribing (component; means) to a presence service for receipt of notifications about the attainability of said mobile terminal device," (figure 2, column 9 lines 1-4), sending alert message to SMS-GMSC, in response to mobile station updating its routing area to the serving node (SGSN) and the serving node sending this information to the HLR, (figure 2, column 9 lines 20-22, 30-32 and 35-37), forwarding short message to SMS-GSMC when SM-SC receives an alert message from the SMS-GMSC, (figure 2, column 9 lines 45-52), the SMS-GMSC examines the address of the mobile station and request routing information from the HLR which returns an acknowledgment of the message with the current SGSN address and the MSC/VLR address of the mobile station, reading on the claimed "initiating (component; means) a delivery attempt of said message to said mobile terminal device upon receipt of notifications about the attainability of said mobile terminal device," (figure 2, column 9 lines 53-64).

However, Salin et al. fail to specifically disclose that the message is forwarded when availability information indicates that the mobile station will accept the message.

In the same field of endeavor, Rooke et al. clearly show and disclose a method for delivering messages in a communication network consisting of at least one terminal and a messaging functionality, wherein the method comprises the steps of submitting information concerning the capabilities of the terminal and

a current user profile thereof from said terminal to said messaging functionality upon the occurrence of a predetermined condition; deciding by said messaging functionality according to said information how to handle a message for said terminal received by said messaging functionality; and handling said message by said messaging functionality according to the result of said decision step, (paragraphs 8, 9). The decision how to handle the submission is based on the circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to said terminal are available to respective decision means, (paragraph 19). The result of the decision as to how to handle the multimedia message can be that it shall be delivered completely, in part or modified, that it shall be discarded, stored in the multimedia messaging service center or forwarded, for example, to an internet email-address, reading on the claimed "checking (component; means) availability information of said mobile terminal device in said presence service for an indication of whether said mobile terminal will accept said message, initiating (component; means) a delivery attempt of said message to said mobile terminal when said availability information indicates that said mobile terminal device will accept said message, wherein said availability information comprises information selected from a group of type of message, size of the message, data content of the message, location of said mobile terminal device and willingness of a user of said mobile terminal device to receive a message," (paragraph 24).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow a MMSC to decide how a message should be handle before sending it as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 2**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 1 above**, and in addition, Salin et al. further disclose SGSN sending information on the fact that the mobile station is again reachable to the HLR which sends an alert message to the SMS-GMSC. The SMS-GMSC then sends an alert message to the SM-SC, which then forwards the short message to the SMS-GMSC, reading on the claimed "receiving a status change notification message from said presence service about said mobile terminal device having a change of said availability information, starting a delivery attempt of said message to said mobile terminal device, in accordance with said received status change notification message" (column 9 lines 29-37).

Consider **claim 3**, Salin et al., as modified by Rooke et al. clearly show and disclose the claimed invention **as applied to claim 1**, and in addition, Rooke et al. further disclose that the submission of a multimedia message as an example for a message to be delivered in a communication network is handled according to capabilities and a user profile of a recipient terminal like for example

a mobile station, reading on the claimed "message is a multi media message," (paragraph 19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow multimedia messages to be delivered in a communication network as taught by Rooke et al. in the method of Salin et al. in order to permit subscribers to send and receive different types of messages.

Consider **claim 4**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 1 above**, and in addition, Salin et al. further disclose the SM-SC receives a short message for delivery to the mobile station, reading on the claimed "receiving of said message to be transmitted to said mobile terminal device" (column 7 lines 63-65).

Consider **claim 5**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 1 above**, and in addition, Salin et al. further disclose the SGSN sending information on the fact that the mobile station is again reachable, to the HLR, in response to the mobile station sending the SGSN a message on its presence. Then SMS-GSMC receives an alert from the HLR, reading on the claimed "checking availability information of said mobile terminal device in said presence service for the availability of said mobile terminal device" (column 9 lines 30-37).

Consider **claim 6**, Salin et al., as modified by Rooke et al. clearly show and disclose the claimed invention **as applied to claim 1 above**, and in addition,

Rooke et al. further disclose that a new multimedia message is received by the multimedia messaging service center (MMSC), which is able to decide which type of delivery has to be selected, based on the terminal capabilities and the current user profile stored in the MMSC, reading on the claimed "availability information for acceptance of said message is depending on properties of said message" (paragraph 20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the MMSC to the delivery of multimedia messages as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 7**, Salin et al., as modified by Rooke et al. clearly show and disclose the claimed invention **as applied to claim 6 above**, and in addition, Rooke et al. further disclose that the decision how to handle the submission of a multimedia message is based on the circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to the terminal are available to decision means, reading on the claimed "properties are selected from a group comprising: message type, message size, sender type, and sender" (paragraph 19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the MMSC to use the size and type of message to decide on delivery of multimedia messages as taught by

Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 8**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 1 above**, and in addition, Salin et al. further disclose the mobile station updating its routing area and sending a message on its presence to the SGSN, which proceeds to send this information to the HLR, reading on the claimed "availability information of said mobile terminal device in said presence service can arbitrarily be changed by receiving said presence service status change message from said mobile terminal device" (column 9 lines 21-32).

Consider **claim 15**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 13 above**, and in addition, Salin et al. further disclose the SM-SC receiving a short message for delivery to the mobile station, reading on the claimed "a component for receiving messages to be transmitted to said mobile terminal device" (column 7 lines 63-65).

Consider **claim 16**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 12 above**, and in addition, Rooke et al. further disclose that there are several possible conditions when to submit the information from the terminal to the multimedia messaging service center and the possibility of updating is not limited to only one condition.

However, the update should be coupled to the necessity to update, or at least to the possibility of submitting the information with other data (this can be any

signaling sequence between these two network elements) that has to be submitted, in order to avoid a cluttering of traffic. Consequently, the condition when the terminal starts its signaling sequence to submit the information is predetermined. This condition can be a change of connection conditions of said terminal, a notification of said multimedia messaging service center concerning the presence and/or the contents of a new multimedia message to said terminal, or the like, reading on the claimed "a component configured to change said availability information in said presence service of said mobile terminal device according to the reception of a presence service status change message from said mobile terminal device" (paragraph 29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow a MMSC to update the capabilities of the terminal when a presence notification is received as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 18**, Salin et al., as modified by Rook et al., clearly show and disclose the claimed invention **as applied claim 17 above**, and in addition, Rooke et al. further disclose that there are several possible conditions when to submit the information from the terminal to the multimedia messaging service center and the possibility of updating is not limited to only one condition. However, the update should be coupled to the necessity to update, or at least to the possibility of submitting the information with other data (this can be any

signaling sequence between these two network elements) that has to be submitted, in order to avoid a cluttering of traffic. Consequently, the condition when the terminal starts its signaling sequence to submit the information is predetermined. This condition can be a change of connection conditions of said terminal, a notification of said multimedia messaging service center concerning the presence and/or the contents of a new multimedia message to said terminal, or the like, reading on the claimed "means for changing said availability information in said presence service of said mobile terminal device according to the reception of a presence service status change message from said mobile terminal device," (paragraph 29).

Consider **claim 19**, Salin et al. clearly show and disclose a method for delivering short messages to mobile stations. Salin et al. further disclose a situation where a mobile station MS is attached to a GPRS network and a GSM network, and the short message service center (SM-SC) has received a short message (SM) for delivery to the mobile station, but the mobile station cannot be reached. The SM-SC first forwards the short message to the gateway mobile switching center for short message service (SMS-GMSC) which proceeds to request routing information for the short message from the home location register (HLR) of the mobile station, (abstract, column 7 lines 60-65 and column 8 lines 8-16) characterized by: sending a Set Message Waiting Data message to the HLR of the MS in response to a failed delivery attempt (Failure Report) to the SMS-GMSC, (figure 2, column 8 lines 39-42 and 59-62) and acknowledging receipt of

Set Message Waiting Data message from SMS-GMSC to HLR, (figure 2, column 9 lines 1-4), sending alert message to SMS-GMSC, in response to mobile station updating its routing area to the serving node (SGSN) and the serving node sending this information to the HLR, (figure 2, column 9 lines 20-22, 30-32 and 35-37), forwarding short message to SMS-GSMC when SM-SC receives an alert message from the SMS-GMSC, (figure 2, column 9 lines 45-52), the SMS-GMSC examines the address of the mobile station and request routing information from the HLR which returns an acknowledgment of the message with the current SGSN address and the MSC/VLR address of the mobile station, reading on the claimed "system, comprising a mobile terminal device, and a store and forward entity configured to receive a notification about an unsuccessful delivery attempt of a message to said mobile terminal device from said store and forward entity, wherein said store and forward entity is responsive to said notification about an unsuccessful delivery attempt, and is configured to subscribe to a presence service for receipt of at least one notification about the attainability of said mobile terminal device, wherein said store and forward entity is configured to initiate a delivery attempt of said message to said mobile terminal device upon receipt of at least one notification about the attainability of said mobile terminal device," (figure 2, column 9 lines 53-64).

However, Salin et al. fail to specifically disclose that the message is forwarded when availability information indicates that the mobile station will accept the message.

In the same field of endeavor, Rooke et al. clearly show and disclose a method for delivering messages in a communication network consisting of at least one terminal and a messaging functionality, wherein the method comprises the steps of submitting information concerning the capabilities of the terminal and a current user profile thereof from said terminal to said messaging functionality upon the occurrence of a predetermined condition; deciding by said messaging functionality according to said information how to handle a message for said terminal received by said messaging functionality; and handling said message by said messaging functionality according to the result of said decision step, (paragraphs 8, 9). The decision how to handle the submission is based on the circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to said terminal are available to respective decision means, (paragraph 19). The result of the decision as to how to handle the multimedia message can be that it shall be delivered completely, in part or modified, that it shall be discarded, stored in the multimedia messaging service center or forwarded, for example, to an internet email-address, reading on the claimed "system comprising a mobile terminal device, and a store and forward entity wherein availability information in said presence service provides an indication of whether said mobile terminal device will accept said message wherein said store and forward entity is configured to initiate a delivery attempt of said message to said mobile terminal device when said availability information indicates that said mobile terminal

device will accept said message, and wherein said availability information comprises information selected from a group of: type of message, size of the message, data content of the message, location of said mobile terminal device and willingness of a user of said mobile terminal device to receive a message," (paragraph 24).

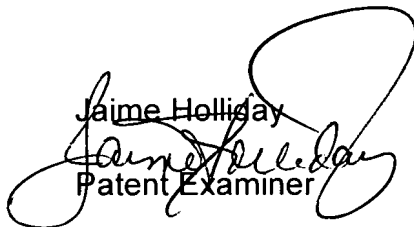
Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow a MMSC to decide how a message should be handle before sending it as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jaime Holliday
Patent Examiner

JEAN GELIN
PRIMARY EXAMINER
